

Remarks/Arguments

Claim 5 is amended to recite a method for a receiving device to operate either in view Claim 1 or Claim 3. Support for the operation of the amended claim is found in the specification on page 7, line 8 to page 9, line 10, and in other places.

Claim 6 is cancelled.

No new matter was added in view of these amendments.

The Examiner objected to the specification because of the specification indicating a page 4 and a page 4A. Applicants note that the replacement page procedure during the PCT phase required the addition of the page 4A. Applicants respectfully requests that the Examiner make the appropriate amendment to the page number, if the Examiner deems such an amendment necessary.

I. 35 U.S.C. § 102(e) Rejection of Claims 1-6

The Examiner rejected Claims 1-6 under 35 U.S.C. § 102(e), as being anticipated by Lee et al. (WO 98/11704, hereafter referred to as 'Lee'). Applicants disagree with this rejection.

Claim 1 claims a step of "determining whether the called device is already connected to the internet". The Examiner rejected Claim 1 on the basis of step 430 of Fig. 5 of Lee. Specifically, the Examiner writes that Lee teaches the above recited step if a "caller's appliance may be set-up to automatically select the Internet call mode if the number dialed checks with the Internal phone book." The Examiner further writes that, "[I]n this mode of operation, the called device is determined not connecting to the Internet".

Applicants assert that this section cited by the Examiner of Lee neither discloses or suggests the claimed step of "determining whether the called device is already connected to the Internet." Lee describes in the specification for step 430 that a caller's appliance determines if a recipient's number is either local or long-distance phone number. In step 432, the caller's appliance determines if the telephone number is associated with an appliance user, the caller's appliance asks the caller whether an Internet call is desired.

The automatic mode cited to by the Examiner is for the benefit of the caller as to automatically select an Internet calling mode, without being prompted when a telephone number is associated with an appliance user (see Lee, page 14, line

30 to page 15, line 1). This part of the specification cited by the Examiner does not disclose whether "a called device is already connected to the internet", as claimed in Claim 1. Additionally, the specification discloses that a caller can select that an Internet call be placed if telephone number is associated with an appliance user (step 434). This decision made by the caller has nothing to do with whether a "called device is already connected to the internet" as claimed in Claim 1.

The Examiner rejected Claim 3 using the same type of argumentation as and cites to the same sections of Lee as used for Claim 1. Applicants assert that Lee does not teach or suggest the claimed element of "determining whether the called device is connected to the IP network" as claimed in Claim 3. As with Claim 1, the automatic mode cited to by the Examiner is for the benefit of the caller as to automatically select an Internet calling mode, without being prompted when a telephone number is associated with an appliance user (see Lee, page 14, line 30 to page 15, line 1). This part of the specification cited by the Examiner does not disclose whether "the called device is connected to the IP network", as claimed in Claim 3.

Furthermore, the Examiner states that the claimed "initiating a PSTN telephone call with a distinctive ringing pattern" is disclosed in Lee by stating that "if an Internet call is desired, the caller's appliance will dial the number and will make sure to allow for a maximum of only two or three rings". The Examiner then concludes in the Office Action that, "the maximum of only two or three rings is considered as a distinctive ringing pattern, (Office Action, page 3, lines 15-20). Applicants disagree with the Examiner.

Lee discloses that these two or three rings is the duration for the operation of step 440 for "the recipient's appliance identify the caller's phone number", (Lee, page 15, lines 2-5). Applicants are unsure how these "two or three rings" are a distinctive call pattern, as there is nothing in Lee that discloses or suggests how these two or three rings are any different from any other ringing pattern that would indicate to the called device that it should be connected "to the IP network in response to the distinctive pattern". The period of the two or three rings are used to identify a caller's telephone number, which is different than "connecting the called device to the IP network in response to the distinctive ringing pattern" as claimed in Claim 3. These comments also apply to Claim 4 in regards to the Examiner's cited teaching of Lee of a "distinctive ringing pattern".

Claim 5 is amended to claim a receiving apparatus that is capable of receiving an IP voice call, if the receiving apparatus is connected to an IP network. If not, the receiving apparatus will connect to the IP network for an IP

voice call in response to distinctive ringing pattern or caller ID information. The claimed receiving apparatus of amended Claim 5 is neither disclosed nor suggested in Lee for the arguments given in connection for Claim 1 and 3.


The rejection to Claim 6 is moot because the claim is cancelled.

Applicants request that the Examiner remove the rejection to Claims 1, 3, and 5 for the reasons listed above. Applicants also request that the Examiner remove the rejections to Claim 2 and 4 as these claims depend on allowable Claims 1 and 3, respectively.

Applicants are filing this paper with a request for a three month extension under 37 C.F.R. 1.136(a). All the fees owed in connection with this action are to be charged to Deposit Account 07-0832, as indicated in the fee sheet being filed with this response. Please charge any other fees owed in connection with this response to this deposit account, as well.

The Examiner is invited to contact the Applicants' attorney at (609) 734-6809, so that a mutually convenient date and time for a telephonic interview may be scheduled.

Respectfully submitted,

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I hereby certify that this correspondence is being transmitted to the Hon. Commissioner for Patents at the telephone number (703) 872-9306 on June 3, 2004.


Joel M. Fogelson